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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/818,765 | 03/27/2001 | Shuichi Yamaguchi | 448563/0191 | 2415 |

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12/03/2003

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EXAMINER

NGUYEN, JUDY

ART UNIT

PAPER NUMBER

2861

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 09/818,765 | Applicant(s) YAMAGUCHI ET AL. | |
| | Examiner Judy Nguyen | Art Unit 2861 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4 and 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2, 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Schmidt et al (US 5,732,751).

Schmidt et al discloses all features of the claimed invention as follows:

- Positioning the spent ink bag (column 2, lines 34+ indicates that depleted/spent ink bag 24 can be refilled; column 11, lines 1+ indicates that filling process could also be used for refill; and Figure 4 illustrates the fill port 52 of the bag 24 being positioned for filling/refilling; hence, discloses the step of positioning the spent ink bag 24).
- Inserting an ink needle (202) into a port (52) of the spent ink bag (24).

- Discharging ink from the spent ink bag only through said port (this is done by evacuating the contents of the spent ink bag (24) via vacuum source connected to the gas conduit branch 208 (Column 9, lines 31-45; note that when the bag 24 is being sucked by the vacuum source; valve 64 must be closed; hence the contents of the spent ink bag 24 is being discharged only through port 52).
- After said discharging step, charging the spent ink bag only through said port with a specified quantity of ink (column 9, lines 45-58).
- Removing the spent ink bag (24) from the ink jet recorder (the step is necessary, therefore, inherent, because the fill port 52 must be exposed so that the nozzle assembly 200 can be connected to it as illustrated in Figure 4).

Claims 3 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Scheffelin et al (US 5,675,367).

Scheffelin et al discloses all features of the claimed invention:

- Removing the ink bag (within print cartridge 226) from the ink jet recorder (the step is necessary for refilling, therefore, inherent).
- Positioning the ink bag (illustrated in Fig. 40).
- Inserting an in needle (212) into a second opening (26) that is different than the first opening (46).
- Charging the ink bag only through the second opening (26) with a specified quantity of ink.

- With respect to the second opening comprising an ink supply port selectively engageable with an ink jet recorder, this limitation basically recites an intended use of the second opening which does not affect the process of refilling of the ink bag. Whether the second opening is capable of engaging with the ink jet recorder or not, it does not affect the refilling of the ink bag in any way. Therefore, such intended use does not further limit the claimed refilling method.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3, 4, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vollert (DE 3401071 A1) in view of Ecklund (US 5,359,356).

Vollert discloses all features of the claimed invention including the followings:

- Removing the ink bag (within 2) from the ink jet recorder (see the before and after removing illustrated in Figures 1 and 2).
- Positioning the ink bag (illustrated in Fig. 2).
- Inserting an in needle (17) into a second opening (9/8) that is different than the first opening (46).
- Charging the ink bag only through the second opening (9/8) with a specified quantity of ink.

However, Vollert does not disclose a first opening where ink is initially filled there through and the ink bag having, disposed on a line, the first opening and an opposing second opening.


Nevertheless, Ecklund discloses that a bag for containing ink with a first opening where ink is initially filled there through and the bag having, disposed on a line, the first opening and an opposing second opening is an equivalent to the bag with only one opening (column 6, line 24-32).

Because the ink bag with two openings and the one with one opening was art-recognized equivalent for containing ink and filling with ink, one of ordinary skill in the art would have found it obvious to substitute Vollert's ink bag having only one opening with Ecklund's ink bag with two openings as defined in the claims for the purpose of containing ink.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy Nguyen whose telephone number is (703) 305-7062. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ben Fuller can be reached on (703) 308-0079. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Judy Nguyen
Primary Examiner
November 25, 2003